

**THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: February 23, 2004

Opposition No. **91152044**

MONSTER CABLE PRODUCTS, INC.

v.

JOEL BARRY SHAMITOFF

Before Simms, Seeherman and Quinn,
Administrative Trademark Judges.

By the Board:

Joel Barry Shamitoff ("applicant") seeks to register the mark MONSTERSNAPS in typed form for "toys and playthings, namely dolls and plush toys" in International Class 28.¹

Monster Cable Products, Inc. ("opposer") has opposed registration of applicant's mark on the grounds that it so resembles opposer's previously used and registered family of marks which include the word MONSTER ("MONSTER marks"²) as

¹ Application Serial No. 76278209, filed June 29, 2001, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

² Opposer's eighteen pleaded registrations for marks containing the word MONSTER include the following:

Registration No. 1342164 for MONSTER CABLE in typed form for "electrical signal transmitting cable and connectors therefor" in International Class 9, issued August 25, 1998.

Registration No. 1414284 for I AM A MONSTER in typed form for "t-shirts and jackets" in International Class 25, issued October 21, 1986.

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to be likely to cause "confusion, deception and mistake"³ and "will dilute or tend to dilute" its MONSTER marks.⁴

Applicant, in his answer, denied the salient allegations of the notices of opposition.

This case now comes up for consideration of applicant's motion (filed March 27, 2003) for summary judgment in his favor on both of opposer's grounds. The motion has been fully briefed.⁵

After reviewing the parties' arguments and exhibits, we find that applicant has not met his burden of establishing that no genuine issues of material fact exist with regard to either ground and that, based on the undisputed facts, he is entitled to judgment as a matter of law. With regard to opposer's likelihood of confusion ground, at a minimum, there exist genuine issues of material fact as to the similarity of the overall commercial impressions of the marks at issue; as to the extent of third-party use of the

Registration No. 2184002 for MONSTER in typed form for "electrical and musical signal transmitting cable and connectors" in International Class 9, issued August 25, 1998.

³ Although opposer has not specifically stated so in its notice of opposition, this ground is pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

⁴ Although opposer has not specifically stated so in its notice of opposition, this ground is pursuant to Trademark Act Section 43(c), 15 U.S.C. Section 1125(c).

⁵ In our discretion, we have considered applicant's reply brief because it clarifies the issues before us. See Trademark Rule 2.127(a).

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term "monster" as a mark and, thus, as to the strength of opposer's pleaded marks; and as to the relatedness of the parties' goods, and, in particular, whether the normal zone of expansion of trade for opposer's pleaded goods encompasses applicant's goods.

We turn next to applicant's motion for summary judgment in his favor on opposer's dilution ground. Although applicant has not filed a motion to strike, our review of the pleadings in connection with the motion for summary judgment reveals that opposer has not adequately pleaded the ground of dilution. In particular, opposer has not alleged that its MONSTER marks became famous prior to the earlier of either the filing date of applicant's application or the date of first use of applicant's mark. See *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000). Accordingly, opposer is allowed until thirty days from the mailing date of this order to file an amended pleading in which the ground of dilution is adequately set forth, failing which this claim will not be further considered.

However, in view of the fact that applicant has moved for summary judgment on the dilution ground, and so as not to further delay this proceeding, we hereby rule on

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applicant's motion with respect to this claim. At a minimum, there exist genuine issues of material fact as to the fame of opposer's MONSTER marks in the context of a dilution claim.⁶

In view thereof, applicant's motion for summary judgment is hereby denied.⁷ Proceedings herein are resumed. Trial dates are reset as follows:

⁶ Applicant contends that he is entitled to summary judgment on opposer's dilution claim because opposer's MONSTER marks are not famous in the field of toys. However, opposer need neither allege nor prove that its MONSTER marks are famous in the field of toys. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1174-82.

Applicant contends in addition that, in view of the Supreme Court's decision in *Victor Moseley v. V Secret Catalogue, Inc.*, 123 S.Ct. 1115, 65 USPQ2d 1801 (2003), opposer is precluded from opposing applicant's Section 1(b) application on the ground of dilution because it cannot show actual harm. However, in a Board *inter partes* proceeding, a plaintiff that establishes its ownership of a distinctive and famous mark may prevail upon a showing of likelihood of dilution against a Section 1(b) application, even though the plaintiff cannot show actual dilution. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1174 ("an application based on an intent to use the mark in commerce satisfies the commerce requirement of the [Federal Trademark Dilution Act] for proceedings before the Board."). The Board has stated that no statement in the *Moseley* decision runs counter to this conclusion. See *The NASDAQ Stock Market, Inc. v. Antartica, S.r.L.*, ___ USPQ2d ___ (TTAB, Opposition No. 121,204, June 30, 2003).

⁷ The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying applicant's motion for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

The parties should note that the evidence submitted in connection with applicant's motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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Plaintiff's thirty-day testimony period to close: **5/7/04**

Defendant's thirty-day testimony period to close: **7/6/04**

Fifteen-day rebuttal testimony period to close: **8/20/04**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.